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KENDEK INDUSTRY SDN BHD

v.

ECOTHERM (TFT) SDN BHD

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HIGH COURT MALAYA, KUALA LUMPUR
AZAHAR MOHAMED J
[SUIT NO: D-22(IP)-1487-2005]
9 APRIL 2010

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PATENTS: *Utility Innovation - Invalidation of utility innovation - Certificate of utility innovation for roller used in latex products industry granted on ex parte basis - Whether certificate conclusive as to validity of utility innovation - Whether grounds for invalidation under s. 56 Patents Act, 1983 applicable - Whether disclosure of utility innovation clear and complete enough to be performed by a skilled person - Claim drafted*

D

vaguely and inconclusively - Claim non compliant with reg. 13(1) Patents Regulations 1986 - Utility innovation invalidated under s. 56(2)(b) Patents Act, 1983

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This action was in respect of a "utility innovation" under the Patent Act 1983 (the Act). The plaintiff claimed that the defendant had infringed its utility innovation No MY 107629 A for "Material Composition of Paris for Use in Dipped Latex Products Industry" (the UI). The subject matter of the UI related to a roller, which is a moveable part in the dipped latex industry to produce dipped latex products. According to the plaintiff, the UI disclosed a composition for a movable part in the said industry using plastics and fibre-glass as a mixture. The plaintiff contended that the Grey EC Roller manufactured by the defendant had infringed the UI in question. The defendant counter claimed that the UI granted was not a validly granted utility innovation in that it did not meet the requirements of either the Act or the Patents Regulations 1986 (the regulations). The UI was innovated by Lai Chee Fong (PW1), from the plaintiff company, to solve the problems caused by rollers used before 17 September 1993 in the manufacturing of dipped latex products industry. There was no evidence that rollers in the dipped latex industry were made of polymers and fibreglass compositions, in Malaysia and/or overseas, before 1993. PW1 was the first to innovate it, market it and commercialise it, through the plaintiff's company. The plaintiff also argued that the Patent Registry found that the UI claim and description adequately met the requirements of the Act and Regulations and thereby, granted the certificate of UI. Secondly, the UI had been challenged in the High Court previously where the court had held that the UI at the material time was valid and subsisting on 29 June 1999.

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Held (dismissing the plaintiff's claim and allowing the defendant's counter claim):

(1) The Patent Registry granted the certificate of UI on an *ex parte* basis. The issue whether an applicant has fully complied with the prerequisites can seldom be conclusively determined at the application stage at the Patent Registry. The Act makes the court the ultimate adjudicator to decide on the validity of the UI. The fact that the UI has been granted by the Patent Registry does not preclude the UI from being challenged in court. (para 26)

(2) The grounds for invalidation of a patent under s. 56 are equally applicable to the invalidation of a UI. A UI if invalidated by the court will be regarded as null and void from the date of grant of the UI. The onus to prove invalidity lies with the defendant. (para 24)

(3) The UI must be disclosed in a way that is clear and complete enough for it to be performed by a person skilled in the art. Non-compliance with this requirement is a ground for revocation after grant. The court would require the assistance of the man skilled in the art in the exercise of construing the validity of the grant of the UI. (paras 30 & 52)

(4) The claim was not specific as to what other "movable parts", or which specific movable part, which the composition claimed. According to DW1, as a person skilled in the art, he would not be able to provide a non-exhaustive list of movable parts or know specifically, from the reading of the claim, which movable parts were sought to be protected by the plaintiff. This indicated that the skilled person, in this case DW1, had difficulty in understanding the language used in light of common general knowledge. (paras 42 & 43)

(5) The manner the claim was drafted resulted in vagueness and inconclusiveness. It could not be said that the claim affirmed in precise language the legal limits of the monopoly granted by the UI. The claim of the UI in question did not comply with Regulation 13(1) in that it was neither clear nor concise nor was it fully supported by the description. Non-compliance with the Regulations is a ground for invalidation of the utility innovation, pursuant to s. 56(2)(b) of the Act. (para 44)

(6) A person skilled in the art could not determine the utility of the UI without subjecting the claim to undue experimentations, contrary to Regulation 12(c) of the Regulations and to s. 23 of the Act. This again implied that the skilled person had difficulty in comprehending the words used in light of common general knowledge. (para 67)

(7) Therefore, MY-10629-A had always been invalid and unenforceable. MY-10629-A was thus revoked and invalidated as of its date of grant. (para 69)

Case(s) referred to:
Asahi v. WR Grace 22 IPR 491 ***(refd)***
Catnic v. Hill & Smith [1982] RPC 183 ***(refd)***
Electric & Musical Industries v. Lissen Ltd [1938] 4 All ER 224 ***(refd)***
General Clutch Corp v. Sbriggs Pty Ltd [1997] 38 IPR 359 ***(refd)***
General Tire & Rubber Company v. Firestone Tyre & Rubber Company Limited [1972] RPC 457 ***(refd)***
Kendek Industry Sdn Bhd v. Yong Wee Hong & Ors [2000] 7 MLJ 569 ***(refd)***
Kirin-Amgen v. Hoechst [2005] 1 All ER 677 ***(refd)***
Lubrizol Corp v. Esso Petroleum Co Ltd And Others [1998] RPC 727 ***(refd)***
Mentor Corporation And Anor v. Hollister Inc [1993] RPC 7 ***(refd)***
Merck & Co Inc v. Generics (UK) Ltd [2004] RPC 31 ***(refd)***
Natural Colour Kinematograph Co Ltd v. Bisochemes Ltd [1915] 32 RFC 256 ***(refd)***
NV Philips Gloeilampenfabriken v. Mirabella International [1993] AIPC 91-025 ***(refd)***
Technip France SA's Patent [2004] RFC 46 ***(refd)***
Valensi v. British Radio Corporation [1973] RFC 337 ***(refd)***

Legislation referred to:
Patents Act 1983, ss. 17(A), 23, 56(2)(b), 57
Patents Regulations 1986, regs. 5, 12(1)(c), (e), 13(1), 15

For the plaintiff - Sri Dev Nair; M/s Sri Dev Nair & Nalia
For the defendant - SF Wong (Michelle Loi with him); M/s Shearn Delamore

Reported by Amutha Suppayah

JUDGMENT

Azahar Mohamed J:

[1] This action is in respect of a "utility innovation" under the Patents Act 1983 (the Act). A utility innovation is not a patent.

[2] A utility innovation is an exclusive right granted for a 'minor' invention that falls short of the inventive step and novelty bars required for patent protection. It is at times described as utility

models, petty patents or by some other name. A utility innovation is protected for an initial period of ten years, which may be extended for another two five-year term. All in all, it provides a total protection for a total of 20 years.

[3] The subject matter of the utility innovation in the present suit relates to a roller, which is a moveable part in the dipped latex industry to produce dipped latex products such as condoms, balloons, gloves and finger cots.

[4] According to Kendek Industry Sdn Bhd (the plaintiff), the utility innovation discloses a composition for a movable part in the said industry using plastics and fibre-glass as a mixture.

[5] The plaintiff claims that Ecotherm Sdn Bhd (the defendant) had infringed its utility innovation No MY 107629 A for "Material Composition of Paris for Use in Dipped Latex Products Industry" (the UI).

[6] For ease of reference, I reproduce below the plaintiff's rollers for which, according to the plaintiff, the UI protects under the Act.

[7] The plaintiff contends that the Grey EC Roller manufactured by the defendant had infringed the UI in question.

[8] On the other hand, the defendant counter claims that the UI granted is not a validly granted utility innovation in that it did not meet the requirements of either the Act or the Patents Regulations 1986 (the Regulations).

[9] At this point, it is convenient to make a short summary of the rival contentions of the parties.

The Plaintiff's Case

[10] The plaintiff is the owner of certificate of the UI. The filing date of the application of the UI is 17 September 1993. It was validly granted on 15 May 1996. The certificate is still valid and subsisting. The validity of the certificate was challenged in the High Court (Kuala Lumpur) in Suit No. D5-22-788-1996 and the court after a full trial held on 29 June 1999 that the certificate to be valid.

[11] The UI was innovated by Lai Chee Fong (PW1), from the plaintiff Company, to solve the problems caused by rollers used before 17 September 1993 in the manufacturing of dipped latex products industry. Before 1993, rollers were made of cast iron, rubber or mild steel. The rollers ran on the metallic tracks in the production line. The metal-to-metal contact created problems; there were contamination and noise pollution. The metal-to-metal abrasion resulted in the metal particles falling down into the latex tank below causing pinholes in the dipped latex products produced. All the manufacturers of dipped latex products faced this problem. No one in the industry except for PW1 decided to embark on a research and development exercise to resolve this problem. He thought of various alternatives and considered whether the use of other materials to replace the metallic rollers was a viable solution. He considered the properties of each material and assessed which material could last for long period under high temperature and resist wear and tear. He was on the lookout for a material that did not result in fine particles dropping into the latex tank causing pinholes.

[12] PW1 started to conduct intensive research in early 1990 in his office and in one injection-moulding factory. His research was tested out under confidential disclosure agreement with the factory. Three years after he initiated his research activities, PW1 found a workable range of composition, which could be used, for the rollers and other movable parts in the dipped latex industry.

[13] Having expended close to RM80,000 for the research and development of his innovation, PW1 immediately sought a patent lawyer and filed an application for the UI for at the Malaysian Intellectual Property Office (MyIPO).

[14] There is no evidence that rollers in the dipped latex industry were made of polymers and fibreglass compositions, in Malaysia and/or overseas, before 1993. PW1 was the first to innovate it, market it and commercialise it, through the plaintiff's company. Since 1993, more than 50,000 pieces of the rollers have been sold and the rollers are well accepted by the industry and are still used to date.

[15] The defendant has manufactured and sold rollers for the dipped latex industry (glove manufacturing companies) at a date after the grant of the UI and after the judgment of the court in Suit No. D5-22-788-1996.

[16] The plaintiff obtained a sample of the defendant's roller from the market and had it analysed by SIRIM Berhad. The analysis reports dated 14 February 2005 and 16 March 2005 show that the composition of the rollers falls within the claim of the UI. Therefore, the UI has been infringed.

[17] It is the plaintiff's case that as at 17 September 2003, a person skilled in the art, armed with common general knowledge of the technology would be able to reproduce the rollers with the parameters claimed, for the use in the dipped latex industry. In fact, the defendant itself had reproduced the rollers without further research. The plaintiff contends that a person skilled in the art would be able to reproduce the invention following the teachings in the UI.

[18] The plaintiff only has to establish that the composition of the rollers used in the dipped latex industry is novel. There is no necessity under the Act to inventiveness. In other words, as long the claimed composition is novel as at the date of filing of the application, the application is valid, even though the composition may not be inventive or obvious to a person skilled in the art.

The Defendant's Case

[19] The UI, as at its priority date is unworkable, insufficient and is not supported by descriptions found in the said UI. It does not meet the requirements found in regs. 12, 13 and 15 of the Regulations and as such, it is invalid pursuant to s. 56 of the Act. Thus, the UI is unenforceable against third parties including the defendant.

[20] The innovation that is claimed in the UI is an unworkable variant of the materials (ie, polymers and fibre glass) and compositions (ie, the percentage ranges), in light of the rigorous and demanding nature of the latex manufacturing industry where movable parts are continuously subject to repeated heat, acid and alkaline exposures. The innovation is incapable of industrial application, contrary to s. 17 of the Act.

[21] Further, there is no demonstrable or acknowledged success for the innovation found in the UI. The claim is in any event insufficient and skilled person in the art will not be able to determine the utility of the innovation using common general knowledge without subjecting the claim to undue experimentation, contrary to reg. 12(c) of the Regulations and pursuant to s. 23 of the Act. In particular:

A a. The claim did not set out the innovation with any reasonable degree of precision and particularity;

b. Those skilled in the art would not understand what is claimed nor would they understand the scope of the claim read in the light of the description. The claim is confined to broad range
B of compositions used for the movable parts but does not, in particular, specify the exact or permissible workable range in percentage terms of the compositions for each and different type of named polymers and fibreglass. The subject matter in this suit does not also pay regard to the different properties
C inherently found in the named polymers and their respective chemical resistances within the latex manufacturing industry. There is no definition for "other like polymers" and there is no specific temperature range of the latex manufacturing industry within which the compositions can operate; and

D c. The only temperature range mentioned (260-290 degree Celsius) is found in the descriptions (not the claim) and is confined to fibreglass-reinforced nylon. Experiments conducted by the Defendant and authoritative publications on polymers demonstrate that even at a temperature of 260 degree celsius,
E the moulding of the movable parts at the mixture of 95wt% Nylon 6 and 5wt% fibreglass at the said temperature failed.

[22] The description of the UI lacks particularity in that it fails to provide the best mode or an enabling description of the innovation;
F and the claim has failed to clearly point out the invention, contrary to reg. 13(1) of the Regulations. In particular:

a. The claim is for the composition of movable parts. Yet, movable parts are not defined in the descriptions.

G b. The description and claim, viewed together, are inadequate when read by one skilled in the art, whether or not he is involved in the latex product industry.

Findings Of Court

H **[23]** Section 17 of the Act defines a "utility innovation" as any innovation which creates a new product or process, or any improvement of a known product or process, or any new improvement of a known product or process which is capable of industrial application".

I **[24]** By s. 17(A) of the Act, the Second Schedule of the Act applies to utility innovations. The relevant section is s. 56, which comes under Part X1 of the Act. Although s. 56 refers to

invalidation of a patent, it equally applies to invalidation of a utility innovation. The grounds for invalidation of a patent under s. 56 for that reason is equally applicable to the invalidation of a utility innovation. Section 57 of the Act, whilst referable to a patent, is equally applicable in the case of utility innovations. Section 57 is under Part XI of the Act and by Part XI of the Second Schedule to the Act, a utility innovation if invalidated by the court will be regarded as null and void from the date of grant of the utility innovation. An application for grant of a utility innovation must have a description, claim, drawings and an abstract. (See: reg. 5 of the Regulations).

[25] Now, there is no denial of the defendant in manufacturing the Grey EC Roller where the plaintiff contends that the defendant has infringed the UI in question. Hence, I will have to deal with and resolve the issue of the validity of the UI in the first instance.

[26] Before dealing with the specific issues which arise for the decision in the counter claim, I would like to clarify two preliminary points raised by learned counsel for the plaintiff.

[27] In the very first place, he argued that the Patent Registry had examined the UI application against the requirements under the Act and had found that the UI satisfied each requirement therein and thereby, granted the certificate of UI to the plaintiff. Learned counsel argued that the Patent Registry could have raised an adverse report raising grounds that the defendant raises in this case, namely the UI claim is neither clear nor concise and that the description in the UI is insufficient and has no enabling disclosure. As argued by learned counsel, the Patent Registry found that the UI claim and description adequately met the requirements of the Act and Regulations and thereby, granted the certificate of UI. Regarding this argument, it must be emphasised here that the Patent Registry granted the certificate of UI on an *ex parte* basis. The issue whether an applicant has fully complied with the prerequisites can seldom be conclusively determined at the application stage at the Patent Registry. Most importantly, the Act makes the court the ultimate adjudicator to decide on the validity of the UI. The fact that the UI has been granted by the Patent Registry does not preclude the UI from being challenged in this court of law. The validity of the UI can only be conclusively decided by the court. The UI can only withstand the scrutiny of the court if the UI, *inter alia*, fully meets the terms provided under the Act and the Regulations, failing which, it can be invalidated pursuant to s. 56 of the Act.

[28] Secondly, learned counsel for the plaintiff argued that the UI has been challenged in the High Court of Malaya at Kuala Lumpur (Commercial Division) Suit No. D5-22-788-1996 and the court, through Steve Shim J (as he then was) held, after a full trial, that the UI at the material time was valid and subsisting on 29 June 1999. The full judgment of the learned judge is reported as *Kendek Industry Sdn Bhd v. Yong Wee Hong & Ors* [2000] 7 MLJ 569. This High Court judgment was not appealed on. Now, as can be seen from the judgment, the invalidity objections raised by the defendant in the present case are of a different kind raised in the earlier case. The thrust of the defendants' invalidity contention in the earlier case was that the UI was prior disclosed in books and literature and therefore was not new at the filing date of the UI. However, the grounds relied upon in the present case are entirely different. It must be emphasised that the decision of that earlier case is confined to the factual matrix of that very case. I do not think that the decision in the earlier case can assist the plaintiff in the present case.

[29] Now, there can be no doubt that on the issue of invalidity, the onus of proof lies with the defendant.

[30] I shall now deal with the argument of learned counsel for the defendant that the claim of the UI did not comply with reg. 13(1) in that it is neither clear nor concise. It is a statutory requirement that the UI must be disclosed in a way that is clear and complete enough for it to be performed by a person skilled in the art. Indeed, the claim defines the scope of protection. Non-compliance with this requirement is a ground for revocation after grant.

[31] It is true that a rigid approach to interpretation of the UI could deprive the plaintiff of effective protection. But to my mind, providing effective protection for the plaintiff must be balanced by the interests of third parties who need to be able to see, from the claim, the extent of the monopoly granted so that they can reasonably ascertain that any activities they are contemplating do not fall foul of the Act (see; *Intellectual Property* (6 edn) by David I Bainbridge).

[32] Before proceeding further, there is an important principal to bear in mind. According to *Terrell Law of Patents,* (2000) edn, it is necessary to identify persons skilled in the art in a given case so that the court may determine what the state of knowledge of such persons are at the relevant time and then adopt the mantle of the notional skilled man before proceeding to construe the claim in the light of that knowledge.

[33] In this very context, Aldous J explained in the case *Lubrizol Corp v. Esso Petroleum Co Ltd And Others* [1998] R.P.C. 727:

> Patent specifications (description) are intended to be read by persons skilled in the relevant art, but their construction is for the court, Thus, the court must adopt the mantle of the notional skilled addressee and determine, from the language used, what the notional skilled addressee would understand to be the ambit of the claim. To do that it is often necessary for the Court to be informed as to the meaning of technical words and phrases and what was, at the relevant time, the common general knowledge; the knowledge that the notional skilled man would have.

[34] As for what constitutes common general knowledge of the persons skilled in the art, the leading statement of what constitutes common general knowledge is to be found in *General Tire & Rubber Company v. Firestone Tyre & Rubber Company Limited* [1972] R.P.C 457, which has often been quoted in other patent cases:

> ... the common general knowledge is a different concept derived from a commonsense approach to the practical question of what would in fact be known to an appropriately skilled addressee the sort of man, good at his job that could be found in real life ...

[35] *Terrell Law of Patents,* (2000) edn, takes the common general knowledge requirement further by stating that proof of common general knowledge can be given by witnesses competent to speak upon the matter, who, to supplement their own recollections, may refer to standard works upon the subject which were published at the time and which were known to them.

[36] In this regard, Lord Diplock in *Catnic v. Hill & Smith* [1982] R.P.C. 183 at pp. 242-243 observes that a patent specification is addressed to those likely to have practical interest in the subject-matter of the invention (notional skilled person). They are those with practical knowledge and experience of the kind of work in which the invention is intended to be used.

[37] Lord Hoffman in *Kirin-Amgen v. Hoechst* [2005] 1 All ER 677 said, "In the case of a patent specification, the notional addressee is the person skilled in the art. He (or, I say once and for all, she) comes to a reading of the specification with common general knowledge of the art".

[38] This is also according to the case of *Technip France SA's Patent* [2004] RFC 46 where Jacob LJ explained:

> The "man skilled in the art" is invoked at many critical points of patent law. The claims of a patent must be understood as if read by that notional man - in the hackneyed but convenient phrase the court

A "must don the mantle of the skilled man". Likewise many questions of validity (obviousness and insufficiency for instance) depend upon trying to view matters as he would see them.

[39] The above paragraphs are very significant principles of law to follow. Thus, it stands established that this court requires the B assistance of the man skilled in the art in the exercise of construing the validity of the grant of the UI in question. In this regard, both PW2 and DW1 are qualified and experienced experts in this field. DW1 in his testimony has explained in detail the common general knowledge relating to issues at hand, which C include the generalization of the category of polymers, the role of fibreglass and why it is to be used as a compound element with thermoplastics and the variant factors in the dipped latex industry. DW1 referred to two publications, namely, Charles A Harper's Handbook of Plastic & Elastomers and Charles A. Harper's Modern D Plastic Handbooks and a number of other online sources. According to DW1, these publications are readily available for purchase as reference materials and they are materials readily accessible. DW1 further noted that these are the publications which engineers, polymer scientists and people who are involved in the plastic E industries would want to refer to and the information are matters which are common general knowledge, ie, within the stock of existing knowledge. It is for all these reasons that in donning the mantle of the skilled man, I am more inclined to rely on the evidence of DW1. His evidence has enlightened this court on the special meaning of technical or scientific terms used in the UI F document and the common general knowledge of the art relating to the issue at hand. However, at the end of the day, all questions in connection with the interpretation of the claim and specification of the UI must be resolved by this court. It is for the court, not for DW1 and PW2 to come to a decision on the matter of G construction.

[40] Coming back to the defendant's contention that the claim of the UI did not comply with reg. 13(1) in that it is neither clear nor concise, it is of critical importance to note that the claim in the present case reads as follows:

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> A composition for movable parts in a dipped latex products industry, such as rollers made from a composition of 5 to 60% fibre-glass mixed with 95 to 40% polymer selected from nylon, PC (polycarbonate), PET (polyethylene terephtalate), PPO (polyphenylene oxide), PBT (polybuthlene terephthalate), and ABS (acryronitrile butadiene strylene) and other like polymers.

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[41] According to DW1, the claim unequivocally and unambiguously suggests that "rollers" are just one of the examples of "movable parts" without making it clear what the "movable parts" are intended. This is clear by the adoption and use of the term "such as rollers" in the claim.

[42] As can be seen, the claim was not specific as to what other "movable parts", or which specific movable part, which the composition claimed. "Movable parts", as indicated in the claim, to my mind, are vague and too general. I cannot construe that "rollers" form the legal limit of the scope of the claim.

[43] It seems to me that the document suggests that "rollers" remain as an example of what "movable parts" are. However, there were no other examples of other "movable parts". According to DW1, as a person skilled in the art, he would not be able to provide a non-exhaustive list of movable parts or know specifically, from the reading of the claim, which movable parts are sought to be protected by the plaintiff. This indicates that the skilled person, in this case DW1, has difficulty in understanding the language used in light of common general knowledge.

[44] Now, "movable parts" entail the whole thing that are moved and can be moved; they are as extensive and wide-ranging as to admit all possibility. Furthermore, other like-polymers referred is also not defined clearly in the claim. Viewed in this light, the manner the claim is drafted has resulted in vagueness and inconclusiveness. It cannot be said that the claim affirmed in precise language the legal limits of the monopoly granted by the UI. In this regard, I do not think it is permissible to construe the claim by reference to the subjective thoughts, intentions, and purposes of the plaintiff. The purpose of the claim is to convey to the public what monopoly the plaintiff has chosen to obtain (see: *Merck & Co Inc v. Generics (UK) Ltd* [2004] R.P.C. 31). Quite the reverse, in my judgment the language of the present claim has caused this court to contemplate what precisely the claim protects. This is the reason why I am of the view that the claim in UI does not set out the parameters and boundaries of protection conferred on the plaintiff. The claim fails to mark out the legal limit of the monopoly granted by the UI. To put the matter in context, I refer to the case of *Kirin-Amgen v. Hoechst* [2005] 1 All ER 677, where Lord Hoffmann quoted with approval the definition of claim decided by Lord Russell of Killowen in *Electric & Musical Industries v. Lissen Ltd* [1938] 4 All ER 224:

> The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to

A limit, and not to extend, the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document Nevertheless, the forbidden field must be found in the language of the claims, and not elsewhere.

The need to set clear limits upon the monopoly is not only, as Lord
B Russell emphasized, the interests of others who need to know the area 'within which they will be trespassers' but also in the interests of the patentee, who needs to be able to make it clear that he lays no claim to prior art or insufficiently enabled products or processes which would invalidate the patent.

C **[45]** To my mind, the plaintiff in the claim did not state clearly and distinctly, what are the UI, that they desired to protect.

[46] I agree with the explanation of DW1 to the effect that the claim language could have simply said "a movable part being a
D roller or plurality of rollers made from a composition ... etc", or "a movable part comprising a roller or rollers made from a composition ... etc", "which comprises", "including", "Consisting of, or even "consisting essentially of". Depending on the context of usages, these phrases, when followed by examples of the different parts of movable parts in the dipped latex industry could be taken to be
E exhaustive and hence, are able to give the innovation so claimed better form of clarity and conciseness, which elements are both required by reg. 13(1) of the Regulations. Learned counsel for the defendant has brought to my attention the following cases that have dealt and mulled over the precise meaning of the choice of phrases
F such as that of "comprise", and "consisting essentially of".

[47] In the Australian case of *Asahi v. WR Grace* 22 IPR 491, it was held at p. 515 that in the circumstances of the case, 'comprise' was being used 'exhaustively'. See also the decision of *NV Philips Gloeilampenfabriken v. Mirabella International* [1993] AIPC 91-025 at
G p. 39, 597.

[48] In the case of *General Clutch Corp v. Sbriggs Pty Ltd* [1997] 38 IPR 359, after a review of the authorities and several dictionaries, the court concluded that the normal linguistic meaning for
H 'comprising' is 'made up of', 'composed of' or constituted by the integers listed. However, that would depend on the context in which the word 'comprising' is used.

[49] In the case of *Natural Colour Kinematograph Co Ltd v. Bisochemes Ltd* [1915] 32 RFC 256, Lord Loreburn in his speech
I said at p. 266, *inter alia* said:

> It is the duty of the patentee to state clearly and distinctly, either in direct words or by clear and distinct reference, the nature and limits of what he claims. If he uses language which, when fairly read, is avoidably obscure or ambiguous, the patent is invalid, whether the defect be due to design, or to carelessness or to want of skill. Where the invention is difficult to explain, due allowance will of course be made for any resulting difficulty in the language. But nothing can excuse the use of ambiguous language when simple language can easily be employed, and the only safe way is for the patentee to do his best to be clear and intelligible.

[50] In my respectful view, there is no other case that is clearer than this on this point.

[51] That is why, there is much merit in the argument of learned counsel for the defendant, and I agree with him that the claim of the UI in question did not comply with reg. 13(1) in that it is neither clear nor concise nor is it fully supported by the description. The plaintiff is under a statutory obligation to express in the claim plainly and specifically, what are the utility innovations which it desires to protect.

[52] Non-compliance with the regulations of the Regulations is a ground for invalidation of the utility innovation, pursuant to s. 56(2)(b) of the Act. That provision says that the court shall invalidate any registered UI if the description or the claim does not comply with the requirements of s. 23, which section provides that the grant of the UI must comply with the Regulations.

[53] Still, there are other issues brought up, which must also be dealt with.

[54] It is further argued by learned counsel for the defendant the description (sometimes referred to the specification) did not comply with reg. 12(1)(c) in that it did not disclose the innovation in such terms that it can be understood and in a manner sufficiently clear and complete for the innovation to be evaluated and to be carried out by a person having ordinary skills in the art.

[55] One of the principles of construction is that the specification should be read and construed objectively through the eyes of the persons to whom it is addressed and to whom common general knowledge is imputed (see: Narayanan (2006) Patent Law). Sufficiency is decided by the court judged through the eyes of a person skilled in the art (see: *Intellectual Property Law* by L Bently and B Sherman (3rd edn) Oxford)

[56] In the case of *Mentor Corporation And Anor v. Hollister Inc* [1993] RPC 7, Lloyd LJ has this to say:

> The question for decision in the present case is whether the specification discloses the invention clear enough and completely enough for it to be performed by a person skilled in the art. This obviously involves a question of degree. Disclosure of an invention does not have to be complete in every detail, so that anyone, whether skilled or not, can perform it. Since the specification is addressed to the skilled man, it is sufficient if the addressee can understand the invention as described, and can then perform it. In performing the invention the skilled man does not have to be told what is self-evident, or what is part of common general knowledge, that is to say, what is known to persons versed in the art. But then, comes the difficulty. How much else may the skilled man be expected to do for himself?

[57] What I gather from decided cases is that DW1 is not required to undertake any detailed analysis, research, experimentation or inquiry to determine what is the subject of the innovation attempted to be described in the description and sought to be claimed in the claim (see: *Mentor Corporation And Anor v. Hollister Inc* [1993] RFC 7 and *Valensi v. British Radio Corporation* [1973] RFC 337).

[58] In the UI, the descriptions state that the present invention discloses a composition for parts for use in the dipped latex products using plastics and fibre-glass as a mixture. It has been discovered by the inventor (PW1) that the use of 5% to 60% of fibre-glass by weight to nylon results in a composition which is highly suitable for the moulding of parts for use in the dipped latex products industry.

[59] It has also been found that instead of nylon, other plastics material such as PC (polycarbonate), PET (polyethylene terephthalate), PPO (polyphenylene oxide), PBT (polybutylene terephthalate) and ABS (Acryronitrile Butadiene Strylene) are suitable parts for, but not limited to, the use of such compositions as rollers.

[60] The mixture of fibre-glass and nylon can be done on the site of manufacturing the parts by introducing appropriate measured amounts of the fibre-glass and nylon resins into the moulding equipment.

[61] The rollers with the fibre-glass nylon composition can withstand temperatures up to 260°C - 290°C.

[62] Samples of products using the composition as previously mentioned include circular rollers.

[63] Now, it is a requirement that the description of a utility innovation must disclose the innovation in such terms that it can be understood in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state any advantageous effects of the invention with reference to the background art. One of the reasons the plaintiff is statutorily required to disclose the details of the UI together with the methodology involved in its working is to enable others to make use of the UI and benefit from after the expiration of the monopoly period enjoyed by the plaintiff.

[64] The description of the UI must also state the best mode (sometimes described as the "preferred embodiment") contemplated by the plaintiff for carrying out the innovation by using examples whenever appropriate and by referring to the drawings, if any.

[65] On these issues, I find that the testimony of DW1 to be particularly helpful on the common general knowledge of the art pertaining to the UI in question. A very important principle to bear in mind is that the "man skilled in the art" is not a person of exceptional skill and knowledge where he is not to be expected to exercise any invention nor any prolonged research, inquiry or experiment. In this very context, I find no valid reason to reject the evidence of DW1 to the effect that of the limited experiments he had conducted on the claimed composition, he found it to be not workable.

[66] Based on the evidence before this court, it is my findings that the description does not consider nor address the different variant factors that are responsible for or can give rise to different outcome of the composition, namely:

a. The combination of different types of polymers with fibre-glass (which again is dependent on its being long or short fibre-glass) yields reinforced polymers that exhibit different reactions to rigorous dipped latex industry environment. These different types of polymers are indicated in the claim but end with the words "other like polymers". Each polymer has different inherent chemical properties;

b. The different range of contemplated percentages in the compound between polymer and fibre-glass (ie, 5-60% of fibre glass with 95-40% of polymer) will yield different results and outcome; and

A c. the rigorous dipped latex industry which environment such as that of repeated (cyclical loading) exposure to heat temperatures ranging from as low as 140°C to as high as 300°C, acid and alkaline will influence different results and outcomes.

B **[67]** As explained by DW1, these omissions render a person skilled in the art, not being able to determine the utility of the innovation without subjecting the claim to undue experimentations, contrary to reg. 12(c) of the Regulations and to s. 23 of the Act. This again implies that the skilled person, in this case DW1, has difficulty in comprehending the words used in light of common general
C knowledge.

[68] In my view, the description merely describes a range of composition of the given proportion and it does not clearly and concisely teach the skilled reader how that composition of the range
D will work with nylon or each of the types of the polymer mentioned in the claim, contrary to reg. 12(c) of the Regulations. Further, against reg. 12(e) of the Regulations, the description does not state the best range.

[69] To sum it up, based on all the previously mentioned reasons,
E I allow the defendant's counter-claim and I accordingly make the following order:

a. I grant an order in terms of prayer (a) of the counterclaim, that is to say, a declaration that MY-10629-A is and has always
F been invalid and unenforceable;

b. I grant an order in terms of prayer (b) of the counterclaim, that is to say, an order that MY-10629-A be revoked and invalidated as of its date of grant, it being 15 May 1996: and

G c. I also order the plaintiff to pay the defendant costs to be taxed.

[70] Consequently, I dismiss the whole of the plaintiff's claim.

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